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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT R. FRIEDLANDER and  
KATHLEEN COVERT KIMMEL

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Appeal 2009-007298  
Application 09/849,291  
Technology Center 3600

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Decided: June 4, 2010

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*Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.  
FETTING, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-33. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for implementing technical change in an organization having multiple hierarchies by predicting a response of an organization to technical change, and then recommending corrective action so that the technical change can be implemented without complication (Spec. 1:6-10). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A computer implemented method for preparing for implementing technical change in an organization having multiple hierarchies, comprising the steps of:

in preparation for implementing a pre-determined proposed technical change in hardware or software used in a working environment of the organization:

querying a hierarchy in the organization to obtain a baseline response regarding skills and training of members of the hierarchy based on those that are needed to implement the technical change;

automatically quantifying the baseline response into a raw score that indicates the skills and the training by assigning a value to each baseline response;

modifying the raw score using at least one modifier that relates to how responsive members of the hierarchy traditionally are to change to yield a skill score; and

comparing the skill score to a predetermined required score to determine a predicted response to the technical change; and  
outputting the predicted response to the technical change.

The references of record relied upon by the Examiner as evidence of anticipation are:

Guinta	US 6,161,101	Dec. 12, 2000
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Bill Curtis, et al., *People Capability Maturity Model*<sup>SM</sup>, Software Eng'g Inst., 0, L1-L4 (1995) (hereinafter "Curtis").

Michael Bobic, et al., *The Kirton adaption-innovation inventory*, 19 Rev. of Pub. Pers. Admin., 18-31 (1999) (hereinafter "Bobic").

Claims 1-14 are rejected under 35 U.S.C. § 101 as being direct to non-statutory subject matter; claims 1-33 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement; claims 1, 3-5, 11, 12, 15, 17, 19, 21, 23, 25, 26, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guinta in view of Curtis; claims 2, 7-10, 14, 16, 22, 24, 27, and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guinta in view of Curtis; claims 6, 13, 20, and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guinta in view of Curtis; and claims 18 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guinta in view of Curtis and Bobic.

We AFFIRM.

## ISSUES

Did the Examiner err in asserting that claims 1-14 do not recite patentable subject matter under 35 U.S.C. § 101?

Did the Examiner err in asserting that claim 1-33 are not enabled under 35 U.S.C. § 112, 1st paragraph?

Did the Examiner err in asserting that a combination of Guinta and Curtis renders obvious the subject matter of claims 15, 17, 19, 21, 23, 25, 26, and 30?

Did the Examiner err in asserting that a combination of Guinta and Curtis renders obvious the subject matter of claims 16, 22, 24, 27, and 31-33?

Did the Examiner err in asserting that a combination of Guinta, Curtis, and Official Notice renders obvious the subject matter of claims 20 and 29?

Did the Examiner err in asserting that a combination of Guinta, Curtis, and Bobic renders obvious the subject matter of claims 18 and 28?

## FINDINGS OF FACT

### *Guinta*

Guinta discloses a method and apparatus that uses a computer to gather information about an organizational process or system by asking an assessor for information about the organizational process or system. Information is gathered by displaying questions on a computer and storing the assessor's responses. As the information is gathered, the responses are analyzed. The analysis performs various functions, such as identifying relevant subject matter, identifying appropriate personnel for submitting responses, accumulating information and evidence relating to the subject matter, filtering biased or exaggerated responses, and identifying potential solutions or improvements (col. 2, ll. 7-19).

The first input may reflect an assessment as to whether the organizational process or system can address an issue (col. 6, ll. 52-54).

Numerical inputs can be modified based on a wide variety of factors preferred by the apparatus designers (col. 9, ll. 44-46).

Figures 7A and 7B are reproduced below.

MAXUS 9000+ (TM) 2.5 CATEGORY MANAGEMENT RESPONSIBILITY S/N: 123 12345678

QUALITY POLICY IS COMMUNICATED, UNDERSTOOD AND MAINTAINED THROUGHOUT THE ORGANIZATION. REF ISO 4.1.1

HOW WELL DOES YOUR PROCESS ADDRESS THIS ISSUE?

0% 20% 40% 60% 80% 100%

SYSTEM IS DEMONSTRABLE ..... YES NO

SUPPORTING DOCUMENTATION EXISTS ..... YES NO

ESC-EXIT F1-HELP SEC: 4.1 NO:1 UNANSWERED QUESTIONS: 16

FIG. 7A

MAXUS 9000+ (TM) 2.5 CATEGORY MANAGEMENT RESPONSIBILITY S/N: 123 12345678

QUALITY POLICY IS COMMUNICATED, UNDERSTOOD AND MAINTAINED THROUGHOUT THE ORGANIZATION. REF ISO 4.1.1

HOW WELL DOES YOUR PROCESS ADDRESS THIS ISSUE?

0% 20% 40% 60% 80% 100%

SYSTEM IS DEMONSTRABLE ..... YES NO

SUPPORTING DOCUMENTATION EXISTS ..... YES NO

ESC-EXIT F1-HELP SEC: 4.1 NO:1 UNANSWERED QUESTIONS: 15

FIG. 7B

Figures 7A-7B, as shown above, depict a series of screen displays for the VIRTUAL ASSESSOR. As shown in Figure 7A, the following initial “ISSUE” or statement within the category “MANAGEMENT RESPONSIBILITY” is displayed: “QUALITY POLICY IS COMMUNICATED, UNDERSTOOD AND MAINTAINED THROUGHOUT THE ORGANIZATION.” The assessor is then prompted to input, on a sliding bar 0-100% scale, a first numerical input that reflects his or her perception as to how well the assessed process (or system) addresses this issue (col. 10, ll. 37-48).

*Curtis*

Curtis discloses that it is directed towards managing the people resources necessary for the development and maintenance of software systems (p. xiv).

*Bobic*

Bobic discloses a system designed to measure a personality dimension claimed significant for understanding and building organizational effectiveness (p. 1)<sup>1</sup>.

## PRINCIPLES OF LAW

*Statutory Subject Matter*

The test to determine whether a claimed process recites patentable subject matter under § 101 is whether: (1) it is tied to a particular machine or

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<sup>1</sup> We reference the page numbering (pp. 1-11) used by the Examiner.

apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances. *Id.* at 963-64.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *Ex parte Langmyr*, 89 USPQ2d 1988, 1996 (BPAI 2008) (informative) (*citing Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)).

#### *Enablement*

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (*citing In re Marzocchi*, 439 F.2d 220, 223-224 (CCPA 1971)).

#### *Obviousness*

A new intended use for an old product does not make a claim to that



old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

One of ordinary skill in the art would have found it obvious to update the prior art device by using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. The combination is thus the adaptation of an old idea or invention using newer technology that is commonly available and understood in the art. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

#### *Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

#### *Official Notice*

To adequately traverse a finding of Official Notice, the appellant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner's

assertion of Official Notice is inadequate. In the absence of any demand by appellant for the examiner to produce authority for his statement, the traversal shall not be considered. *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943).

*Non-Analogous Art*

The test for determining whether a reference is analogous art is (1) whether the reference is in the field of the appellant's endeavor or (2) whether the reference is reasonably pertinent to the problem with which the appellant was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

ANALYSIS

*Statutory Subject Matter*

We are not persuaded that the Examiner erred in asserting that claims 1-14 do not recite statutory subject matter under 35 U.S.C. § 101 (Exam'r's Ans. 4-5; Reply Br. 14-15). As an initial matter, independent claims 1 and 10 do not meet the second prong of the machine-or-transformation test. The modification of a raw score to a skill score is a manipulation of abstract data that is not representative of physical objects or substances. See *In re Bilski*, 545 F.3d at 963-64.

Regarding the first prong, Appellants assert that the recitations in the aforementioned independent claims of “[a] computer implemented method,” “automatically quantifying,” and “automatically assigning” are sufficiently tied to a machine to be statutory subject matter (Reply Br. 14-15). However, the recitations of a “computer” and “automatically” amount to no more than a general purpose computer or the actions of a general purpose computer,

which are insufficient to impart patentability, as a general purpose computer is not a “particular machine” as required by *Bilski*. See *Ex parte Langmyr*, 89 USPQ2d at 1996.

Except as set forth herein, we do not reach the merits of the prior art rejections of claims 1-14 of our decision because we have determined that the aforementioned claims on appeal do not recite patent-eligible subject matter under § 101. See *Diamond v. Diehr*, 450 U.S. 175, 188 (1981); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach an obviousness rejection on appeal after concluding many claims were non-statutory under § 101); *Bilski*, 545 F.3d at 951 n.1 (noting that § 101 is a threshold requirement and that the Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter); *Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (per curiam) (expanded panel) (precedential) (as the claims on appeal do not recite patent-eligible subject matter under § 101, the prior art rejections need not be considered).

#### *Enablement*

We are not persuaded that the Examiner erred in asserting that claims 1-33 are not enabled under 35 U.S.C. § 112, 1st paragraph (App. Br. 7-8; Reply Br. 8). As an initial matter, we are confused by Appellants’ argument that *Ansul Co. v. Uniroyal, Inc.*, 448 F.2d 872 (2d Cir. 1971), *cert. denied*, 404 U.S. 1018 (1972) supersedes or augments *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988) (App. Br. 7). *Ansul* was decided in 1971. *Wands* was decided in 1988, and indeed cites *Ansul*. *Wands*, 858 F.2d at 737.

Accordingly, if anything, *Wands* supersedes or augments *Ansul* with respect to enablement.

The Examiner sets forth an exhaustive analysis of the *Wands* factors as to how the Specification fails to enable claims 1-33 (Exam'r's Ans. 25-35). As the Examiner has met the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by that claim is not adequately enabled by the Specification, the burden shifts to the Appellants to provide suitable proofs indicating that the Specification is indeed enabling. *See In re Wright*, 999 F.2d at 1561-62.

In rebuttal, Appellants essentially argue factor (F) in *Wands*: that the Specification provides sufficient guidance for one of ordinary skill to arrive at the claimed invention via routine experimentation. We disagree. Page 14 of the Specification discloses that a raw score can be determined by assigning values to baseline responses. As an example, values 1-3 are assigned to NO, MAYBE, and YES. While this is some guidance, it is insufficient to show one of ordinary skill how to quantify the infinite array of potential responses to the infinite array of questions that could be used to measure technical change, for example, values for answers other than NO, MAYBE, and YES, and the logic behind combining numbers of non-analogous values. The same problem exists for determining the required score on pages 15-16. Pages 14-15 disclose modifiers such as stiffness and individual modifiers for modifying the raw score. While some examples are given for stiffness modifiers, one of ordinary skill is given no guidance on how to assign values to various factors for individual modifiers. Pages 16-17 disclose comparing a required score to a skill score, and give an example where a score below 10 is a good, and a score above 30 is bad. However, no

analysis is given as to how those numbers were arrived at, or even guidance on how to determine such threshold numbers.

Accordingly, because Appellants have not met the burden of successfully rebutting the Examiner's reasonable explanation as to why the scope of protection provided by that claim is not adequately enabled by the Specification, we will sustain this rejection.

*Obviousness of Claims 15, 17, 19, 21, 23, 25, 26, and 30*

We are not persuaded that the Examiner erred in asserting that a combination of Guinta and Curtis renders obvious the subject matter of claims 15, 17, 19, 21, 23, 25, 26, and 30 (App. Br. 8-11; Reply Br. 9-11). Appellants assert that even if Guinta discloses evaluation and corrective actions, that such actions are not "for preparing for implementing [a] technical change in an organization having multiple hierarchies," as claimed (App. Br. 8-9; Reply Br. 9). However, this is merely a statement of intended use. *See In re Schreiber*, 128 F.3d at 1477.

Appellants assert that neither Guinta nor Curtis is directed toward implementing technical changes in hardware or software used in the working environment of an organization, as claimed (App. Br. 9, 11; Reply Br. 9-10, 11). However, Guinta discloses that it is directed toward assessing and identifying potential solutions or improvements for organizational processes and systems (col. 2, ll. 7-19), which corresponds to the claimed implementing technical changes in the working environment of an organization. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364. Curtis is directed towards managing the people resources necessary for the development and maintenance of software systems (p. xiv), which

necessarily include both hardware and software. Thus, the combination of Guinta and Curtis meets the claimed aspect. *See In re Keller*, 642 F.2d at 426.

Appellants assert that Guinta does not disclose automatically quantifying responses into a raw score, as claimed, because an assessor manually inputs the scores (App. Br. 9-10; Reply Br. 10). However, automating a manual activity is obvious. *See Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d at 1162.

Appellants assert that Guinta does not disclose using a modifier that relates to how responsive members of the hierarchy traditionally are to change (App. Br. 10-11). However, Guinta discloses that numerical inputs can be modified based on a wide variety of factors preferred by the apparatus designers (col. 9, ll. 44-46). One such factor may be an assessment as to whether the organizational process or system can address an issue (col. 6, ll. 52-54), for example, technical change resulting from a potential solution or improvement (col. 2, ll. 17-19).

*Obviousness of Claims 16, 22, 24, 27, and 31-33*

We are not persuaded that the Examiner erred in asserting that a combination of Guinta and Curtis renders obvious the subject matter of claims 16, 22, 24, 27, and 31-33 (App. Br. 12; Reply Br. 12). Appellants assert that Guinta discloses identifying and resolving a current problem, but not predicting a response to a proposed change, as claimed. However, once again, Appellants do not dispute that Guinta discloses the claimed steps regarding evaluation and corrective action. Accordingly, the current problem/proposed change distinction is merely one of intended use. *See In*

*re Schreiber*, 128 F.3d at 1477. Moreover, a proposed change is a current problem. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364. Furthermore, Curtis is cited for the hardware and software of technical changes. *See In re Keller*, 642 F.2d at 426.

*Obviousness of Claims 20 and 29*

We are not persuaded that the Examiner erred in asserting that a combination of Guinta, Curtis, and Official Notice renders obvious the subject matter of claims 20 and 29 (App. Br. 12-13; Reply Br. 12). Specifically,

Appellants assert that a query of an organization to obtain a baseline response used to determine a predicted response to a technical change in the organization, wherein each question in the query is in a yes/no/sometimes format is not obvious to one skilled in the art as asserted by the Examiner.

However, such a general allegation without specific technical reasoning as to why the Examiner's reasoning is in error is insufficient to overcome Official Notice. *See In re Chevenard*, 139 F.2d at 713.

*Obviousness of Claims 18 and 28*

We are not persuaded that the Examiner erred in asserting that a combination of Guinta, Curtis, and Bobic renders obvious the subject matter of claims 18 and 28 (App. Br. 13-14; Reply Br. 13). Appellants assert Guinta and Bobic are non-analogous art. However, all of Guinta, Bobic, and the claimed invention are directed to managing organizational change. *See In re Oetiker*, 977 F.2d at 1447.

Appellants also assert that incorporating the innovator/adaptor quantification from Bobic into Guinta would defeat the intended function of Guinta. However, Guinta discloses that numerical inputs can be modified based on a wide variety of factors (col. 9, ll. 44-46). Furthermore, instead of replacing the second input of Guinta, Bobic is merely an additional layer of input into Guinta (Exam'r's Ans. 41-42). Accordingly, any benefits derived from the second input of Guinta are retained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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